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EXAMINER	
TSUI, WILSON W	

ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/777,046	LERNER ET AL.	
	Examiner	Art Unit	
	WILSON TSUI	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 March 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,5-7,9,10,15,16,21 and 25-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,5-7,9,10,15,16,21 and 25-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This non-final is in response to the RCE filed on: 03/10/10.

2. Claims 1, 3, 4, 8, 11-14, 17-20 and 22-24 are cancelled. Claims 2, 5, 6, 7, 9, 10, 15 and 21 are amended. Claims 27-29 are new. Thus, claims 2, 5-7, 9, 10, 15, 16, 21 and 25-29 are pending.

3. The following rejections are withdrawn, in view of new grounds of rejection necessitated by applicant's amendment:

- Claims 9, 10, 15, and 16 rejected under 35 U.S.C. 102(b) as being anticipated by Keely et al.
- Claims 2, 5, 6, 7, and 25-29 rejected under 35 U.S.C. 102(b) as being anticipated by Hardock et al.

Claim Objections

4. Claims 5 and 6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

With regards to claim 5, the parent claim already requires storing said annotation and storing the static image of the first active content associated with the annotation.

With regards to claim 6, the parent claim already requires storing said annotation and the link to said active content.

Allowable Subject Matter

5. Claim 21 is allowed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 9, 10, 15, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keely et al (US Application: US 2002/0049787, published: Apr. 25, 2002, filed: Dec. 29, 2000), in view of Golovchinsky et al ("Hypertext Interaction Revisited", publisher: ACM, published: May 30, 2000, pages: 171-179).

With regards to claim 9, Keely et al teaches a method of displaying clips comprising the steps of:

receiving at least two display regions of one or more documents, each display region having a set of an annotation and related content, the at least two display regions being extracted from non-contiguous portions of the document or portions of different documents (Figure 13, paragraphs 0090-0098: whereas a plurality of sets of

annotations can be received; each type/classification of annotations are associated with content, the annotations do not have to be next to each other, such as the "asterisk" type annotation is not next to/contiguous with the "connector" type annotation. Additionally specific anchor/region of the document is received/saved along with its related annotation and related context data. This display anchor/region data (having associated annotation and related context data) can be used to display using annotation retrieval/filter criteria, annotation(s) with their related context data);

combining said at least two display regions to form a combination consisting of non-contiguous portions of the one or more documents; filtering said combination of said at least two display regions (paragraph 0015, 0016, 0075, and 0078, Figure 9: whereas, display anchor/region data is used to produce/combine clips comprising annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations);

Rendering resultant image having said clips, wherein at least one of said clips is a clip having the filtered combination of said at least two display regions; and displaying the clips including the at least one clip having the filtered combination of said at least two display regions (paragraph 0078, Figure 9: whereas, the image of the clips of data are rendered, such that the clips are displayed).

However, although Keely et al teaches display regions, as similarly explained in the rejection above, Keely et al does not expressly teach *wherein each display region includes an image of an annotation and related content encompassed by that display region within the one or more documents, ... and wherein said resultant image includes*

the images of the annotations and related content encompassed by said at least two display regions.

Yet, Golovchinsky et al teaches *wherein each display region includes an image of an annotation and related content encompassed by that display region within the one or more documents* (Figure 7: whereas, each annotation, is associated with related content. The annotation and related content encompassed by a region defined by a bounding box (page 175, column 2, whereas, the bounding box is expanded from the annotation to include context/related data), *... and wherein said resultant image includes the images of the annotations and related content encompassed by said at least two display regions* (page 174 (bottom of first column, top of second column): whereas, the a combination of display regions can be combined into a single clip as a theme). Additionally, as explained in page 175, the clippings created can be displayed into a resultant image that includes one or more annotations with their associated content (the clippings can be further filtered by a color).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Keely et al's method for implementing display regions, such that the display regions include an *image* of an annotation and related content encompassed by that display region, as similarly taught by Golovchinsky et al. The combination would have allowed Keely et al to have "encouraged people to interact with text" by having an interface that keeps people focused when working and reading text (Golovchinsky et al, page 176, bottom of first column).

With regards to claim 10, which depends on claim 9, Keely et al teaches further comprising the step of*: storing said clip as said combination of said at least two display regions* (Figure 8A, Figure 8B: whereas storage is implemented).

With regards to claim 15, Keely et al teaches a computer-readable medium having a program stored thereon, said program for displaying clips and comprising the steps of: *receiving at least two display regions of one or more documents the at least two display regions being extracted from non-contiguous portions of the one or more documents* (Figure 13, paragraphs 0090-0098: whereas a plurality of sets of annotations can be received, each set/classification of annotations are associated with content, the annotations do not have to be next to each other, such as the asterisk is not next to/contiguous with the "connector" type annotation. Additionally specific anchor/region of the document is received/saved along with its related annotation and related context data. This display anchor/region data (having associated annotation and related context data) can be used to display using annotation retrieval/filter criteria, annotation(s) with their related context data) ;
combining said at least two display regions to form a combination consisting of non-contiguous portions of the document or portions of the one or more documents; filtering said combination of said at least two display regions (paragraph 0015, 0016, 0075, and 0078, Figure 9: whereas, display anchor/region data is used to produce/combine clips comprising annotations that are filtered per user input, and the clips can comprise a

combination of two or more filtered annotations); *and rendering resultant image having said clips, wherein at least one of said clips is a clip having the filtered combination of said at least two display regions; and displaying the clips including the at least one clip having the filtered combination of said at least two display regions* (paragraph 0078, Figure 9: whereas, the image of the clips of data are rendered, such that the clips are displayed).

However, although Keely et al teaches display regions, as similarly explained in the rejection above, Keely et al does not expressly teach *wherein each display region includes an image of an annotation and related content encompassed by that display region within the one or more documents, … and wherein said resultant image includes the images of the annotations and related content encompassed by said at least two display regions.*

Yet, Golovchinsky et al teaches *wherein each display region includes an image of an annotation and related content encompassed by that display region within the one or more documents, … and wherein said resultant image includes the images of the annotations and related content encompassed by said at least two display regions* (Figure 7: whereas, each annotation, is associated with related content. The annotation and related content encompassed by a region defined by a bounding box (page 5, right column, whereas, the bounding box is expanded from the annotation to include context/related data), *… and wherein said resultant image includes the images of the annotations and related content encompassed by said at least two display regions* (page 4 (bottom of left column, top of right column): whereas, the a combination of

display regions can be combined into a single clip as a theme). Additionally, as explained in page 5, the clippings created can be displayed into a resultant image that includes one or more annotations with their associated content (the clippings can be further filtered by a color).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Keely et al's method for implementing display regions, such that the display regions include an *image* of an annotation and related content encompassed by that display region, as similarly taught by Golovchinsky et al. The combination would have allowed Keely et al to have "encouraged people to interact with text" by having an interface that keeps people focused when working and reading text (Golovchinsky et al, page 6, bottom of first column).

With regards to claim 16, which depends on claim 15, Keely et al and Golovchinsky et al teaches further comprising the step of: *storing said combination of said at least two annotations and related content* (as similarly explained in the rejection for claim 15: whereas, a user can opt to store a combination of annotations with their respective related content as a clipping), and is rejected under similar rationale.

With regards to claim 25, which depends on claim 9, Keely et al teaches *wherein said annotations are from different documents* (Figure 6: whereas annotations can be located on different pages/documents).

With regards to claim 26, which depends on claim 25, Keely et al teaches *wherein said documents are from different application programs* (Figure 1, page 262, right column: whereas documents can be retrieved from different computers, in a distributed environment).

7. Claims 2, 5, 6, 7, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardock et al ("A Marking Based Interface for Collaborative Writing", publisher: ACM, published: November 5, 1993, in view of Golovchinsky et al ("Moving Markup: Repositioning Freeform Annotations, published: October 27, 2002, pages 21-29).

With regards to claim 27, Hardock et al teaches a method of displaying clips comprising the steps of:

Receiving data regarding an annotation which is associated with an active content that is non-static and that is included in a document, displayed in a user interface during a current access session, the active content changes between a previous access session and the current access session (page 260, right column: whereas, received marked up annotations are displayed in a left window and the annotations annotate a document, which is active (since the document's data/layout can change over time/not-static, as explained in page 265, figure 9: whereas, as shown, the layout and content of a paragraph can change due to edits). The active document being

shown in a right window, or contemporaneously in the same window (pages 261 and 265, Figure 4, and Figure 9 respectively);

Storing the annotation as displayed in the current access session (Figure 4: whereas, the annotation is stored and shown in a static image in a left window. The static image, is a static image of an active document);

Storing a link to the active content that was displayed in the user interface at the time of the current access session (Figure 4: whereas, active content/current state of the annotated document is retrieved/linked, such that is the retrieved data is shown in a right window);

Rendering an image having clips, wherein at least one of said clips is a clip having the stored annotation and static image of the active content (Figure 4: whereas the clips has a shown with an annotation and a static image of the document); *and*

Displaying the rendered clips, wherein selection of said annotation in said at least one clip accesses the active content via the stored link (Figure 4, page 260, right column: whereas, a user can point to an annotation in the left view, and the active document is linked for retrieval and displayed in a right window).

However, although Hardock et al teaches displaying the annotation with the static image of the active content, Hardock et al does not expressly teach storing the annotation *together with a static image* of the active content.

Yet Golovchinsky et al teaches storing the annotation *together with a static image* of the active content (Figure 1 and Figure 2: whereas, the document content/layout is changed, such that the annotations are repositioned by retrieving a

static/original-bounding box, and adjusting to a new bounding box when accessing/referencing//linking to active/new-layout-data (page 25, bottom-half of left column).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Hardock et al's method for storing annotation data, such that a static image of the active content is stored together with it, as similarly taught by Golovchinsky et al. The combination would have allowed Hardock et al to have "preserved the correct position of annotation s when documents viewed with different fonts or font sizes, with different aspect ratios, or on different devices" (Golovchinsky et al, page 1, Abstract).

With regards to claim 28, for a computer-readable medium having a program stored thereon, the program performing a method similar to the method performed by claim 27, is rejected under similar rationale.

With regards to claim 29, for a system, which performs a method similar to the method performed by claim 27, is rejected under similar rationale.

With regards to claim 2, which depends on claim 29, Hardock et al teaches *wherein said at least one of said clips includes additional content* (Figure 4: whereas a clip is shown having additional content, the additional content can be the text/context data, or additional annotations from other authors/collaborators (page 265, left column)).

With regards to claim 5, which depends on claim 29, Hardock et al and Golvchinsky et al teaches further comprising: *a storage that stores said annotation and the static image of the active content associated with the annotation* (as similarly explained in the rejection for claim 27 (whereas, the original static image/boundary context is saved with the annotation), and is rejected under similar rationale.

With regards to claim 6, which depends on claim 29, Hardock et al teaches further comprising: *a storage that stores said annotations and the link to said active content* (as similarly explained in the rejection for claim 27: whereas, the annotations are referenced to link/reference document data is active (layout/flow of document can change)), and is rejected under similar rationale.

With regards to claim 7, which depends on claim 29, Hardock et al teaches further comprising: *a storage that stores said annotation and a non-static image of the active content associated with the annotation, wherein the first active content changes over time* (as similarly explained in the rejection for claim 27: whereas annotations are referenced to link/reference document data is active (layout/flow of document can change, and the image boundary is updated/not-static when active content changes), and is rejected under similar rationale.

Response to Arguments

7. Applicant's arguments with respect to claims 2, 5-7, 9, 10, 15, 16, 21 and 25-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wilson Tsui/
Patent Examiner
Art Unit: 2178

September 29, 2010

	/CESAR B PAULA/ Primary Examiner, Art Unit 2178